

REMARKS

1. Restriction Made With Traverse.

Applicant submits that the dark field method and apparatus disclosed and claimed in this patent application is a unitary invention and relate to a single general inventive concept under PCT Rule 13.1. Therefore, the restriction is made with traverse.

An examiner or the Commissioner may require an applicant to restrict an application to one invention if "two or more independent *and* distinct inventions are claimed in one application." 35 USC 121 (2000) (emphasis added). An "independent" invention is an invention that has no "disclosed relationship" to the other disclosed invention(s), that is, the invention is "not connected in design, operation, or effect under the disclosure of the particular application under consideration". See MPEP §§802.01 (2001) and 808.01. A "distinct" invention is an invention that is not "capable of separate manufacture, use, or sale as claimed" or is not patentable over the others. *Id.* Thus, a restriction/election requirement is required only when (1) the inventions are not connected by a common scheme (hence independent) and (2) the inventions are not capable of separate manufacture, use or sale or are patentable over each other (hence distinct).

Claims 1-9 and 22-24 claim a method for determining the living from the dead cells. Claims 10-21 and 25-28 claim an apparatus for determining the living from the dead cells. Although the examiner has stated that the apparatus it self does not provide a contribution over the art, the apparatus is disclosed and claimed in connection with the method. More specifically, the apparatus disclosed and claimed in Claims 10-21 and 25-28 is for use in carrying out the method of Claims 1-9 and 22-24 and is claimed using the language of the method claims. As such, the inventions are interrelated and should not be subject to restriction.

Initially, the examiner has failed to indicate whether the two groups of claims correspond to different classes. However, even if so, "[t]he grounds for restriction are not solely dependant on separate classification. [35 USC] Section 121 permits a restriction for 'independent and distinct inventions,' which the PTO construes to mean that the sets of claims must be drawn to separately patentable inventions. See MPEP §802.01 (stating that the term distinct means two or more disclosed subjects that while perhaps related, such as process and apparatus for its practice,

'ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)'. *Applied Materials Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F3d 1563, 40 USPQ2d 1481 (Fed. Cir. 1996) (Archer, dissenting).

Applicant recognizes that there are claims directed both to a method and to an apparatus. However, this does not automatically create a restriction requirement.

The mere fact that there are separate apparatus and method claims in the same application is not grounds for a restriction. The PTO correctly recognizes these may be just two different ways of claiming the same invention. *** [U]nder the PTO guidelines for restricting claims covering an apparatus and method of using the apparatus, the examiner must show one way distinctiveness. See MPEP § 806.05(e). That is, either the apparatus or method must be capable of being practiced without the other. *** In addition, the examiner must give a reason why it would be a burden to examine both sets of claims; commonly, the reason will be that there are separate classifications requiring independent searches.

Applied Materials, supra; see also *Symbol Technologies, Inc. v. Opticon, Inc.* ... (Fed. Cir. 1991) (determining that method and apparatus claims are not necessarily directed to separate inventions). The examiner has stated a rather perfunctory comment about the apparatus not having an inventive step, but has not complied with the MPEP guidelines concerning the relatedness of the alleged two inventions.

As stated in the MPEP: "A process and apparatus (tool) for its practice can be restricted if either 'the process as claimed can be practiced by another materially different apparatus or by hand' or 'the apparatus as claimed can be used to practice another and materially different process.'" MPEP §806.05(e). In the present application, the apparatus as claimed is used to carry out the method as claimed and, therefore, there is unitary of invention. The apparatus claimed is not capable of being used without using the claimed method, and therefore, they should be considered as one and the same invention. Applicant therefore requests that the examiner withdraw the restriction requirement.

2. Election Made With Traverse.

Applicant submits that the various species listed by the examiner are not independent inventions, but are all part of the same invention. Therefore, the election is made with traverse.

Where, as in the present application, an application contains a generic claim for all of the disclosed species, an election requirement is not usually proper. Inventions for purposes of a restriction requirement that share a common genus or species are not independent and distinct. See 37 CFR §1.141(a) (allowing for an exception where there are more than one species of an invention). In fact, an applicant may join a "reasonable number" of species in an application. See 37 CFR §1.141(a). The reasonable number of species depends on the circumstances.

In the present situation, the species are interdependent and thus not "independent and distinct" because a generic claim links all of the species of the present invention. In the present application, Claims 1, 10, 22, and 25 are linking claims, and the MPEP provides that "[i]f a linking claim is allowed, the examiner *must* thereafter examine species if the linking claim is generic thereto, or he or she *must* examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim." MPEP §809.04 (emphases added); see also *In re Doyle*, 293 F3d 1355, 1358, 1362, 63 USPQ2d 1161 (Fed. Cir. 2002).

Claims to be restricted to different species must be mutually exclusive.

The general test as to when claims are restricted respectively to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

Ex parte Muench, 79 USPQ 92 (Bd. App. 1948). This is not the case in the present application. Using a bright field does not preclude simultaneously using a phase contrast and neither precludes using fluorescent in the same method or apparatus. Any combination can be used together. Thus, as the "species" listed by the examiner are only variants that can be covered by, for example, a Markush claim, a species election is not necessary.

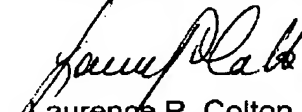
Further, the policies behind the restriction requirement, namely, (1) ensuring fees are received by the USPTO, (2) preventing the USPTO from having to perform excess work, and (3) maintaining the patent classification system, are not violated by withdrawing the restriction requirement in the present case. *See In re Coulter*, 69 USPQ 531 (CCPA 1946); *See also* Chisum On Patents, §12.01. Finally, the examiner will not have to perform an excessive amount of work as all the embodiments likely are classified under the same or related classes. *See cf.* MPEP §808.02 (suggesting the lack of distinct fields or separate classifications are reasons to not require a restriction). And as the present application is directed at a generic method and a generic apparatus, the examiner will not be required to perform a substantial amount of additional work. Thus, it is not inconsistent with USPTO policy to allow the present application to be prosecuted without an election. Applicant therefore requests that the examiner withdraw the election requirement.

CONCLUSION

Applicant has complied with the restriction and election requirements and submits that the patent application is in condition for examination. Further, Applicant submits that both the restriction and election requirements are not necessary in that there is a unity of invention among all of the claims, and that all of the claims should be examined.

If the Commissioner or the examiner has any final questions, please contact the below signed attorney of record at 770.522.9762.

Respectfully submitted,
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